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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/484,964	01/18/2000	Edward T. H. Yeh	UTSH.248	1333

7590 03/29/2006

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EXAMINER	
WEHBE, ANNE MARIE SABRINA	

ART UNIT	PAPER NUMBER
1633	

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/484,964	YEH, EDWARD T. H.	
	Examiner	Art Unit	
	Anne Marie S. Wehbe	1633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *73,88,90-92,98,100 and 101* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *73,90-92,100 and 101* is/are allowed.

6)☒ Claim(s) *88 and 98* is/are rejected.

7)☒ Claim(s) *88 and 98* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *Notice to Comply*.

DETAILED ACTION

A request for continued examination (RCE) under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 2/15/06 has been entered. It is further noted that an Order Dismissing Appeal in view of applicant's submission of an RCE was mailed by the Board of Patent Appeals and Interferences to applicants on 3/7/06.

Applicant's amendment submitted with the RCE has been entered. Claims 1-72, 74-87, 89, 93-97, and 99 are canceled. Claims 73, 88, 90-92, 98 and 100-101 are currently pending in the instant application. An action on the merits follows. Those sections of Title 35, US code, not included in this action can be found in previous office actions.

Claim Rejections - 35 USC § 112

The rejection of previously pending claims 73-75, 86-92, and 94-101 under 35 U.S.C. 112, first paragraph, for lack of written description is withdrawn in view of applicant's cancellation of the claims or amendment of claims 73 and 92 to recite that the nucleic acid segment comprises at least SEQ ID NO:1 or encodes a polypeptide comprising SEQ ID NO:2.

The rejection of claims 73-75, 85-92, and 94-101 under 35 U.S.C. 112, first paragraph, for scope of enablement is withdrawn in view of applicant's cancellation of the claims or amendment of claims 73 and 92 to recite that the cell is *in vitro*, and the nucleic acid segment comprises at least SEQ ID NO:1 or encodes a polypeptide comprising SEQ ID NO:2.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 88 and 98 are newly rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 88 and 98 both depend on canceled claims, claims 86 and 96 respectively. Thus, the metes and bounds of the claims cannot be determined. It is further noted that the claimed methods, as currently amended, now recite that the method is performed *in vitro*. Thus, the limitation in both claims 88 and 98, "..wherein the nucleic acid segment is provided to the animal in an amount effective to prevent apoptosis of the cell", conflicts with limitations of independent claims 73 and 92.

Claim Objections

Claims 88 and 98 are objected to because of the following informalities: claims 88 and 98 depend on a canceled claims 86 and 96 respectively. Appropriate correction is required.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: while the first sentence of the specification has been previously amended to indicate that the instant application is a divisional of parent application 08/964,162, the status of the parent application is not provided as required. It is noted that 08/964,162 is abandoned.

Nucleotide and/or Amino Acid Sequences

This application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Specifically, the Figures 2A, 2B, and 12 of the drawings submitted on 1/18/00 contain numerous nucleotide and amino acid sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821 (a)(1) and (a)(2) and which are not identified by SEQ ID NOS. Please note that compliance to 37 CFR 1.821-1.825 requires that **either** the drawings themselves or the brief description of the drawings in the specification be amended to recite SEQ ID NOS. for each recitation of a sequence in the specification. Further, it is unclear whether these sequences are present in the paper copy and CRF of the sequence listing filed in this application. If the sequences are present in the paper and CRF

listings, applicant may fully comply with 37 CFR 1.821 by amending the drawings or brief description of the drawings in the specification to include the proper SEQ ID NOS. If the sequences are not present on the filed paper and CRF listings, then new paper and CRF sequence listings are required as set forth in the Notice to Comply.

If applicant chooses to amend the drawings instead of the brief description of the drawings in the specification, it is suggested that any replacement drawing sheets provided also address the deficiencies noted in the Draftsperson's Patent Drawing Review (form PTO-948) mailed to the applicants as part of the first office action on 9/28/01, paper no. 10.

Allowable Subject Matter

Claims 73, 90-92, and 100-101 are considered free of the prior art of record and allowable.

Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Wehbé, Ph.D., whose telephone number is (571) 272-0737. If the examiner is not available, the examiner's supervisor, Dave Nguyen, can be reached at (571) 272-0731. For all official communications, **the new technology center fax number is (571) 273-8300**. Please note that all official communications and responses sent by fax must be directed to the technology center fax number. For informal, non-official communications only, the examiner's direct fax number is (571) 273-0737. For any inquiry of a general nature, please call (571) 272-0547.

The applicant can also consult the USPTO's Patent Application Information Retrieval system (PAIR) on the internet for patent application status and history information, and for electronic images of applications. For questions or problems related to PAIR, please call the USPTO Patent Electronic Business Center (Patent EBC) toll free at 1-866-217-9197. Representatives are available daily from 6am to midnight (EST). When calling please have your application serial number or patent number available. For all other customer support, please call the USPTO call center (UCC) at 1-800-786-9199.

Dr. A.M.S. Wehbé

ANNE M. WEHBE' PH.D
PRIMARY EXAMINER

Application No.: 09/484,964

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

[X] 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.

[ ] 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).

[ ] 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).

[ ] 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."

[ ] 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).

[ ] 6. The paper copy of the "Sequence Listing" is not the same as the computer readable from of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).

[X] 7. Other: the sequences in drawing Figures 2A, 2B, and 12 are not identified by SEQ ID NOS and it is unclear whether these segeunces are present and identified by SEQ ID NOS in the paper copy and CRF of the sequence listing on file.

Applicant Must Provide:

[X] An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".

[X] An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.

[X] A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216
For CRF Submission Help, call (703) 308-4212
For PatentIn software help, call (703) 308-6856

PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR RESPONSE